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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,785	07/15/2003	Hisao Furukawa	B-3919DIV 621071-8	1116

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EXAMINER

CHANKONG, DOHM

ART UNIT	PAPER NUMBER
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2152

MAIL DATE	DELIVERY MODE
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05/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/620,785

Applicant(s)

FURUKAWA ET AL.

Examiner

Dohm Chankong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 16-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: ____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :7/15/03, 2/17/04, 7/9/04, 8/22/05, 2/23/06, 2/21/07.

DETAILED ACTION

1> Claims 1-15 were cancelled in a preliminary amendment. Claims 16-22 are added.

Thus, claims 16-22 are presented for examination.

2> This is a non-final rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3> Claims 16 and 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims directed only to software are nonstatutory because software does not fall within any of the statutory categories for patent subject matter eligibility. Claims with software must recite hardware elements that execute the software to bring the claim under one of the statutory categories (such as machine).

Claims 16 and 17 are rejected because the functionality being claimed is software only; while terminals are recited, it is unclear their relationship with the formation of the packet. Applicant's specification also gives no guidance as to how the internal packet is formed or how the terminals participate in the functionality being claimed. As such, these claims are interpreted as being directed solely to software with no hardware elements. Therefore, these claims are rejected for being directed to non-statutory subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4> Claims 16-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 16 recites several elements that are not discussed or described in the specification: an internal packet that is formed based on a sending side network node terminal and an IP packet and a receiving side network node terminal is decided based on node terminal discriminating information of said internal packet. Applicant's specification does not describe or even refer to an internal packet or discriminating information of this internal packet. While the specification refers to network nodes and IP terminals, the specification does not describe sending or receiving side network node terminals.

Claim 17 recites similar elements as claim 16 that are not described in the specification. Additionally, claim 17 recites a sending side network node apparatus and a receiving side access control apparatus. Thus, the subject matter of claims 16-22 are not described in the specification in a manner that would have conveyed to one skilled in the art that Applicant was in possession of the claimed invention.

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5> Claims 16-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 16 recites several elements that are not discussed or described in the specification: an internal packet that is formed based on a sending side network node terminal and an IP packet and a receiving side network node terminal is decided based on node terminal discriminating information of said internal packet. Applicant's specification does not describe or even refer to an internal packet or discriminating information of this internal packet. While the specification refers to network nodes and IP terminals, the specification does not describe sending or receiving side network node terminals. Therefore, Applicant's specification fails to describe these elements as well that would have been enabled one of ordinary skill in the art to have used the invention.

The claim is also unclear as to how the internal packet is formed. The claim merely states that an internal packet is formed based on a sending node terminal and an IP packet; this language gives absolutely no guidance as to how the internal packet is formed. The specification also fails to enable how a receiving network node terminal is decided based on discriminating information of the internal packet.

Claim 17 recites similar elements as claim 16 that are not described in the specification. Additionally, claim 17 recites a sending side network node apparatus and a receiving side access control apparatus. Applicant's specification fails to describe these

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elements as well that would have been enabled one of ordinary skill in the art to have used the invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6> Claims 16-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 16 and 17 are rejected for as the scope of the claim cannot be determined. The claims claim a "network", then rely upon a "wherein" clause to recite the structure and functionality being performed (forming of the internal packet and "deciding" a receiving side terminal). The problem with this claim language is that the functionality being performed cannot be performed by the previously claimed "network"; this problem is compounded by the fact that the claims fail to recite any element that forms the internal packet.

b. Claims 16 and 17 are also rejected for reciting that "a receiving side network terminal is decided." It is unclear exactly how a terminal can be "decided."

c. Claims 16 and 17 are also rejected for reciting that an internal packet is formed based on sending side network node terminal and an IP packet. It is unclear as to how the packet is formed and how the sending side terminal and IP packet relate to the formation of the packet.

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d. Claims 16 and 17 are also rejected for reciting that at least one of the networks (IP data, IP telephone, best effort) are "included" but it is unclear in what claim element these networks are included. For the purposes of this action, the Office will interpret this term as meaning that at least one of the networks are included in the integrated IP network.

e. Claim 22 is rejected because it recites "said IP voice|image network", "said IP data network", "said IP telephone network", and "said best effort network." While claim 16, on which claim 22 depends, does recite these terms, claim 16 does not make these terms mandatory to the construction of the claim. Claim 16 recites that the integrated network only need comprise at least one of the networks. Thus, the language of claim 22 produces an inconsistency - if only network is included in the IP integrated network, then claim 22 would present antecedent problems since the other networks have not been included in the integrated network.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7> Claims 16 are rejected under 35 U.S.C §103(a) as being unpatentable over Mattahil, U.S Patent No. 6.807.169.

8> As to claim 16, Mattahil discloses an integrated IP network [Figure 4], wherein an internal packet is formed based on a sending side network node terminal and an IP packet [column 8 «lines 4-19»], a receiving side network node terminal is decided based on a network node terminal discriminating information of said internal packet [column 6 «lines 55-65» | column 7 «lines 36-57» : selecting a terminating router], and at least one of an IP voice/image network, an IP data network, an IP telephone network, a best effort network is included [Figure 4].

9> As to claim 17, as it does not teach or further define over the limitations of claim 16, claim 17 is rejected for at least the same reasons set forth for claim 16.

10> As to claim 18, Mattahil discloses said integrated IP network is controlled by one or more communication company [column 3 «lines 36-47» where : customer equipment implies a company that controls the network].

11> As to claim 19, Mattahil discloses one or more network node apparatus connected to an IP telephone network therein, and said network node apparatus is connected to an IP telephone machine through a network node terminal of said network node apparatus outside of said integrated IP network [Figure 4 «items 30, 38, 14»].

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12> As to claim 20, Mattahil discloses one or more network node apparatus connected to an IP voice/image network therein, and said network node apparatus is connected to an IP voice image apparatus through a network node terminal of said network node apparatus outside of said integrated network [Figure 4 «items 16, 36, 104, 30 32» | column 5 «lines 1-53»].

13> Claims 21 and 22 are rejected under 35 U.S.C §103(a) as being unpatentable over Elliot et al, U.S Patent No. 5,867,495 [“Elliot”].

14> As to claim 22, Mattahil does disclose that a network node apparatus is connected to an IP terminal, an IP telephone machine or a voice/image apparatus through a network node terminal of said network node apparatus outside of said integrated network [Figure 4 | column 2 «lines 49-62» | column 5 «lines 1-53»] but does not disclose that the network node apparatus is connected to a best effort network.

15> In the same field of invention, Elliot is directed to an integrated IP network [Figure 22]. Elliot discloses that an IP network is generally a best effort network as it handles best effort traffic [column 18 «lines 9-16» | column 19 «lines 6-11»]. Therefore, it would have been obvious to one of ordinary skill in the art to have reasonably inferred that Mattahil's IP network [Figure 4 «item 16»] is also a best effort network as claimed by Applicant because it was well known in the art that IP networks are best effort networks.

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16> As to claim 23, Mattahil does not disclose that an IP voice network, IP data network, IP telephone network or best effort network include a domain name server.

17> Domain name servers and their inclusion in IP networks are well known to one of ordinary skill in the art. Additionally, Elliot discloses a domain name server included in the IP data network and IP telephone network [Figure 19F «item 1906» | column 195 «lines 6-15»]. Therefore, it would have been obvious to one of ordinary skill in the art to have modified Mattahil to include a domain name server in his IP telephone, IP data and IP voice networks to enhance the network's ability to map those network addresses to IP addresses of the internet [see Elliot, column 17 «lines 15-20»].

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Masuda et al, U.S Patent Publication No. 2002|0059432;

Kikinis, U.S Patent No. 6.456.615;

Neyman, U.S Patent No. 6.459.697;

Butler et al, U.S Patent Publication No. 2003|0012183;

Shmulevich et al, U.S Patent No. 6.515.985;

Pirot et al, U.S Patent No. 6.856.676;

Ohta et al, U.S Patent No. 7.209.472.

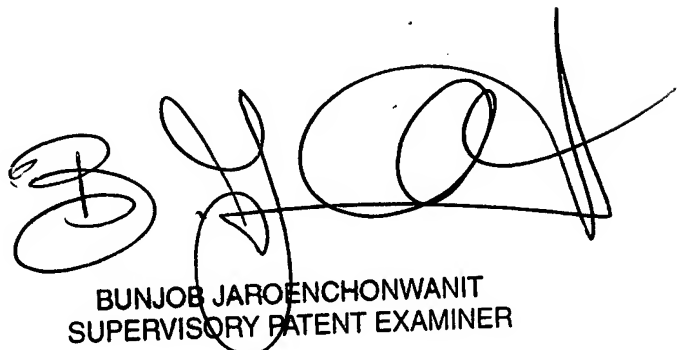
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DC



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